

REMARKS

Claims 1-21 are pending. Favorable consideration of the pending claims in light of the above amendments and following remarks is respectfully requested. Support for the amendments may be found within the entirety of the specification, and particularly at pages 6-8, and 10-11.

Claim Rejections Under 35 U.S.C. § 112

Claims 1, 8, 9 and 13 are rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully submit that the rejection has been obviated by appropriate amendment and the following remarks. Applicants respectfully submit that the subject matter of all pending claims, including prior and current amendments, is described in the originally filed specification.

The application as originally filed describes the subject matter of claims 1 and 13 as previously presented and currently amended. In particular, the specification at page 6, lines 2-4, describes that a “suffix is broadly defined as any applicable coverage from an insurance policy for the claim.” The “insurance policies may have many coverages (i.e. rental, collision, bodily injury), only a few of the coverages are related to any one claim.” The specification at page 6, lines 6-11, describes examples where a suffix is preselected from one or more types of insurance coverage applicable to the claim. In addition, the specification at page 7, lines 2-8, describes that the file note is automatically generated and that the “fields are automatically populated for the handler e.g., suffix, participant). In addition, Figure 1 depicts a claim folder interface that “presents to the handler a high level interface regarding the instant claim, such that the handler can easily identify participants, claimant, vehicles involved, drivers, and any related suffixes

(e.g., rental collision, bodily injury, medical).” Page 10, lines 1-12, describes an example where the handler highlights a suffix to initiate a file note interface that is “prefilled” with information that is displayed to the handler. Accordingly, one skilled in the art would recognize that the specification describes “at least one suffix is preselected from one or more types of insurance coverage applicable to the claim.”

With regard to the rejection of claim 8, Applicants respectfully submit that the specification at pages 7-8 describe that a “participant is an entity involved in the claim.” The specification at page 8, lines 1-3, also provides examples of entities that are “involved in the claim (e.g. police towing company, doctor)” and describes that an insured person may be a participant, as well as a claimant. Accordingly, Applicants respectfully submit that the specification as originally filed describes the subject matter of claim 8.

With regard to the rejection of claim 9, Applicants respectfully submit that the specification at page 8 describes the subject matter of claim 9 previously presented as well as currently amended. The specification at page 8 describes an example where a handler highlights data in a claim folder and selects a button to initiate the creation of a new file note. When the handler initiates the creation, the highlighted data “is loaded in the suffix field 112 and participant field 114.” The category filed is filled with “available categories pertaining to a highlighted suffix in field 112 and participant in participant field 114.” Page 10 of the specification describes an example of a file note screen that displays information that is highlighted by a handler in a claim folder screen. Accordingly, the specification as originally filed describes depicting a selected criteria or at least one attribute in a criteria section.

Rejection Under 35 U.S.C. § 103

Claims 1-21 were rejected under 35 USC §103(a) as being unpatentable over Nolan *et al.* ("Nolan" US Patent 5,253,362) in view of Borghesi *et al.* ("Borghesi" US Patent 5,950,169). Applicants respectfully submit that claims 1-21 are not obvious in view of the cited references.

Independent Claims 1 and 13

Independent claims 1 and 13 both relate to generating a file note for an insurance claim. In the claims, fields identifying the file note are prefilled with a suffix indicating a type of insurance coverage and identification of a participant. The suffix relates not to just any type of coverage, but the type of insurance for the participant. In addition, the suffix is preselected from one or more types of insurance coverage. A selection of fields from the first set of field is obtained to identify information that is displayed in a second set of fields. The user is permitted to add data to predefined text areas related to each field of the second set. The file note is generated and a level of significance of the file note is identified. The file note is stored with the level of significance of the file note in a searchable database that includes file notes associated with the claim. (*see* specification, pp. 10-11). Applicants respectfully submit that the cited references, singly or in combination, do not disclose or suggest the claimed method for generating a file note.

The cited combination of *Nolan* and *Borghesi*, on the other hand, relates to annotations to a patient's medical chart made by a healthcare provider. *Nolan* describes displaying a list of predefined commonly used annotations from which a selection may be made. (col. 5, ll. 51-56). Figure 5 of *Nolan* illustrates a spreadsheet showing groups that are divided into tiles corresponding to parameters. (col. 4, ll. 62-68). The parameter column contains parameter cells

that are “utilized to indicate the parameter for which the data cells contain information.” Figure 3 of *Nolan* shows a “pop up” window that appears up selection of a data cell, not a parameter cell. (col. 5, ll. 14-16). The “pop up” window provides several options, one of which includes a “SHOW DETAIL” option. (col. 5, ll. 16-31). Figure 5, therefore, illustrates another “pop up” window after the user has selected the “SHOW DETAIL” option. Figure 6 shows yet another “pop up” window that is displayed with the list of commonly used annotations. (col. 5, ll. 51-56).

Borghesi relates to managing and processing insurance claims including transmitting a claim assignment from an insurance office computer to a mailbox in a communications server. (Abstract). In *Borghesi*, an insurance claim datafile is generated and managed with a graphic user interface. *Id.* The cited combination therefore relates to allowing the selection of an annotation for an insurance claim data file from a list of commonly used annotations.

In contrast, independent claims 1 and 13 display information that is specifically “identified by selection of field of the first set of fields” in the second set of fields. Claims 1 and 13 obtain a selection of field from the first set of fields, and that selection identifies information specific to a second set of field. The cited combination on the other hand display parameters that indicate a parameter of data cells. The displayed parameters are not selectable, and are not used to obtain a selection of fields. Instead, in the cited combination, the user selects a data cell. In addition, the selection of a data cell in the cited combination does not identify information for a second set of field that is displayed and permits a user to add predefined text; rather, the selection provides a “pop up” window, that provides a list, from which a user may make another selection, in response to which another “pop up” window is provided. Nowhere in the cited combination is it disclosed or suggested to permit the user to add data to a predefined text area, that results from

the selection of a prefilled first set of fields and a second set of fields identified from the selection of the first set of fields. In the claims, the predefined text area relates “to each field of the second set of field based on the selected fields.” That is, claims 1 and 13 do not simply display a list of “commonly used annotations” as does the cited combination. Rather, claims 1 and 13 display information specific to the claim, the participant, and the selected fields. In addition, claims 1 and 13 provide specific areas for text entry based on the selected fields, and not from a list. Neither *Nolan* nor *Borghesi* disclose or fairly suggest displaying information “identified by selection of field of the first set of fields” in the second set of fields and permit the user to add data to a predefined text area, where each area relates “to each field of the second set of field based on the selected fields.”

In addition, claims 1 and 13 also identify a level of significance of the generated file note and stores the identification in a searchable database. The combination of *Nolan* and *Borghesi* does not disclose or fairly suggest identifying or storing any level of significance of a file note. In *Nolan*, at claim 1 at col. 8, ll. 16-17, states “assigning a first notational designator to said first annotation text.” Read in context of the claim and the entirety of the specification, this does not suggest to one skilled in the art to identify a level of significance of the generated file note and stores the identification in a searchable database. First, *Nolan* describes that the “first notational designator” is assigned to the particular “annotation text,” not the an entire file note. Next, the remaining portion of the claim defines the “first notational designator” “indicate[s] that the annotation is associated with said selected first data cell.” (col. 8, ll. 18-20). The claim further defines that the “first notational designator” may be assigned to another annotation text when a second annotation is the same as the first annotation, otherwise a second notational designator

that “indicat[es] the existence of said first annotation” is assigned to the second annotation. (col. 8, ll. 29-35). Accordingly, the “notational designators” indicate an association or existence of the annotations, not to a relative significance of the file note itself. Nothing in the cited combination discloses or suggests identifying a level of significance of the file note. Accordingly, the cited references would not lead one skilled in the art to the claimed invention. Applicants respectfully submit that claims 1 and 13 are not obvious over the cited combination.

Independent Claim 9

Claim 9 relates to generating a file note for an insurance folder where “at least one attribute associated with a claim on the claim folder screen” is selected and depicted in a criteria section. The claim also recites a text entry section that is based on the selected attribute. A level of significance of a generated file note is identified and stored with the file note in a searchable database. The database also associates the file note with a file note index indicating changes to the file note.

As discussed, the cited combination relates to allowing the selection of an annotation for an insurance claim data file from a list of commonly used annotations. Instead of including all common information in a list, as described in *Nolan*, the file note of claim 9 depicts in a criteria section a selected “at least one attribute associated with a claim on the claim folder screen” that is selected. A text entry section based on the selected attribute is also displayed. Applicants respectfully submit that the *Nolan* and *Borghesi* combination does not disclose or fairly suggest depicting at least one selected attribute and related text entry section. Accordingly, the cited references do not lead to the claim 9. Applicants respectfully submit that claim 9 is not obvious over the cited combination.

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Dependent Claims

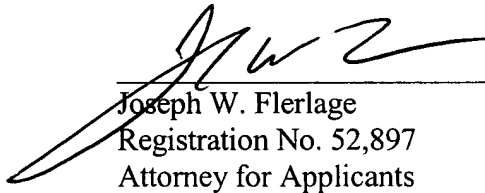
The dependent claims inherit the limitations of the independent claims from which they depend, and therefore, are allowable for reasons discussed above for independent claims 1, 9, and 13.

CONCLUSION

Applicants respectfully request reconsideration of the pending rejections and allowance of the pending claims. The Examiner is invited to call the undersigned if a telephone interview would expedite allowance of the application.

Respectfully submitted,

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